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YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

PHILLIPS, HASSAN A

ART UNIT PAPER NUMBER

2151

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,454

Applicant(s)

KOSUGE, SATORU

Examiner

Hassan Phillips

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to amendments filed on November 16, 2004.

Drawings

2. After consideration of the amendments made to the disclosure, to mention reference characters included in the Figures, the Examiner has withdrawn the objection to the drawings.

Claim Rejections - 35 USC § 112

3. After consideration of the amendments made to the disclosure and claim 7 to remedy unclear terminology, the Examiner has withdrawn the rejection of claim 7 under 35 USC 112, first paragraph.

Response to Arguments

4. Applicant's arguments filed July 19, 2004 have been fully considered but they are not persuasive. Applicant argued that: none of the applied references teach or suggest using previously registered keywords as a basis for obtaining a short text of the electronic mail. Examiner respectfully submits that Applicant has misinterpreted the prior art of record.

In regards to applicant's argument, the Examiner interpreted the limit in the amount of characters to be displayed by the receiver (Fernandez, page 5, lines 1-15), to be the "keywords" claimed in the present invention. It is clear in the teachings of Fernandez that this limit (e.g. 100 characters) is registered before obtaining a short text of the electronic mail, (see Fernandez, page 10, lines 24-28).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "retaining text portions of the e-mail that include registered words relating to dates, place names, proper names and individually set particular terms, and group keywords including an occupation, an occupational type and an age group of an electronic mail sender and receiver", and the keyword analysis server referring to a keyword database storing predetermined group keywords and individual keywords deleting some inessential words from a received e-mail and leaving keywords such as: dates, place names, spots, proper names and individually set particular terms such as: above-captioned case, have studied, your company, proposal, accept, contract various conditions, qualified person, and attend to prepare a short text.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the Examiner has interpreted the claim language as broadly as possible. It is also the Examiner's position that Applicant has not yet submitted claims

drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in a manner that distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterated the need for Applicant to define the claimed invention more clearly and distinctly. Accordingly the references supplied by the examiner in the previous office action covers the claimed limitations. Applicant is requested to review the prior art of record for further consideration.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 3, 6, 7, 11, 14, 17, 19, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fernandez, WO 99/65256 (supplied by Applicant).

7. In considering claims 1, 3, 11, and 17, Fernandez teaches an electronic mail processing system, method, and device comprising:

Receiving means for receiving electronic mail sent to a receiver via internet; analysis means for receiving the electronic mail sent from a sending means via the internet and for carrying out a keyword analysis of a message portion of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of the message portion, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave out words not corresponding to the registered keywords; storing means for storing the short text of the electronic mail obtained after the keyword analysis; and sending means for sending the short text of the electronic mail stored in the storing means to the receiver via the internet in response to access of the receiver, (page 5, lines 1-15).

8. In considering claims 6, 14, and 19, Fernandez teaches an electronic mail processing system, method, and device comprising:

Receiving means for receiving electronic mail sent to a receiver via internet; voice conversion means for receiving the electronic mail sent from a sending means via the internet and for converting content of the received electronic mail into voice signals; an analysis means for carrying out a keyword analysis of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of a message portion of the electronic mail, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave

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out words not corresponding to the registered keywords; reading out means for reading out the voice signals output from the voice conversion means to produce voiced electronic mail; and sending means for sending the voiced electronic mail produced by the reading out means to the receiver via a public telephone network in response to access of the receiver, (page 5, lines 1-15).

9. In considering claim 7, the teachings of Fernandez further show a document output means for outputting a selected reply document in response to a signal sent from the public telephone network, and a reply sending means for preparing electronic mail from the reply document output from the document output means and for sending the prepared electronic mail to the electronic mail sender via the Internet. See page 6, lines 10-16.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 4, 5, 8, 9, 12, 13, 16, 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez in view of Scannell.

12. In considering claims 2, 4, 8, 9, and 16, although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Rearranging the received email.

Nevertheless, in a similar field of endeavor, Scannell teaches a method and system comprising:

- a) A rearrange means for receiving electronic mail sent from a sending means via the Internet and for rearranging the received electronic mail in a priority order previously registered by a receiver of the electronic mail, (col. 2, lines 34-48).

Thus given the teachings of Scannell, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show the receiver registering electronic mail in a priority order so that the received electronic mail can be rearranged for the receiver. Doing so would have provided the receiver with an improved automatic message sorting system driven by the rules created and modified by the receiver, (col. 2, lines 28-31).

13. In considering claims 5, 12, and 18, Fernandez teaches an electronic mail processing system, method, and device comprising:

Receiving means for receiving electronic mail sent to a receiver via internet; storing means for storing the received electronic mail; an analysis means for carrying out a keyword analysis of the received electronic mail on the basis of keywords

previously registered by the receiver to obtain a short text of a message portion of the electronic mail, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave out words not corresponding to the registered keywords; and, a second sending means for sending the received electronic mail stored in the storing means to the receiver via the internet in response to access of the receiver, (page, 5, lines 1-15).

Although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose:

- b) Rearranging the received email.

Nevertheless, in a similar field of endeavor, Scannell teaches a method and system comprising:

- b) A rearrange means for receiving electronic mail sent from a sending means via the Internet and for rearranging the received electronic mail in a priority order previously registered by a receiver of the electronic mail, (col. 2, lines 34-48).

Thus given the teachings of Scannell, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show the receiver registering electronic mail in a priority order so that the received electronic mail can be rearranged for the receiver. Doing so would have provided the receiver with an improved automatic message sorting system driven by the rules created and modified by the receiver, (col. 2, lines 28-31).

14. In considering claim 13, the method taught by Fernandez discloses storing the short text of the electronic mail after the keyword analysis in the receive mailbox, (page 5, lines 1-15).

15. Claim 10, is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez in view of Nelson, U.S. Patent 6,061,718 (supplied by Applicant).

16. In considering claim 10, Fernandez teaches an electronic mail processing system comprising:

First sending means for sending voiced electronic mail to a receiver via a public telephone network; storing means for storing the voiced electronic mail; an analysis means for carrying out a keyword analysis of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of a message portion of the electronic mail, the analysis means selectively shortening the message portion to retain text corresponding to the registered keywords and to leave out words not corresponding to the registered keywords; and second sending means for sending the received electronic mail stored in the storing means to the receiver via the internet in response to access of the receiver of the voiced electronic mail, (page 5, lines 1-15).

Although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose:

a) Converting the voiced electronic mail to text.

Nevertheless, Nelson teaches a method comprising:

- a) A conversion means for receiving voiced electronic mail sent from a first sending means via the public telephone network and for converting content of the voiced electronic mail into a text as content of a communication matter, (col. 4, lines 59-67, col. 5, lines 1-3).

Thus given the teachings of Nelson, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show a conversion means for converting the voiced electronic mail to text. This would have provided an efficient means for allowing the receiver to optionally receive messages in voice or text format, Nelson, col. 4, lines 59-67, col. 5, lines 1-3.

17. Claims 20, 22, 25, 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez in view of Chong et al. (hereinafter Chong), U.S. Patent 5,497,319 (supplied by Applicant).

18. In considering claims 20, 22, 25, and 26, although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

19. Claims 21, 23, 27, 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez and Scannell, in view of Chong.

20. In considering claims 21, 23, 27, and 28, although the disclosed system of Fernandez and Scannell shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Fernandez and Scannell to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

21. Claim 24, is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Chong.

22. In considering claim 24, although the disclosed system of Scannell shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

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Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Scannell to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

23. Claim 29, is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Chong.

24. In considering claim 29, although the disclosed system of Nelson shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Nelson to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner

of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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FRANTZ B. JEAN
PRIMARY EXAMINER